



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/353,537	07/14/1999	STEPHEN Y.F. PANG	19009-000420	3726

7590 09/21/2004

RICHARD T OGAWA
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 941113834

EXAMINER

HO, CHUONG T

ART UNIT	PAPER NUMBER
----------	--------------

2664

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/353,537

Applicant(s)

PANG, STEPHEN Y.F.

Examiner

Chuong Ho

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2664

1. The amendment filed 07/13/2004 have been entered and made of record.
2. Applicant's amendment filed 07/13/2004 with respect to claims 1-20 have been considered but they are not persuasive.

As per to Applicant's argument, the Applicant's argue in substance the following:
McCormick was previously discussed in the Appeal Brief mailed 12/04/03 as "reactive" system that simply filters-out unwanted e-mail messages, but does nothing to prevent them" (page 5, lines 31-32);

Zmail was also previously discussed in the Appeal Brief as a "passive" system that provide e-mail filters but does nothing to prevent further e-mail messages" (page 6, lines 1-2)

The Applicant's argument is not persuasive.

In response to Applicant's argument, McCormick et al. shows an address filtering server which serves as the policing server. Mc Cormick further shows updating of the banned/barred address list by the user (see col. 2, lines 53-63). What Mc Cormick does not show is SPAM icon. Note that Mc Cormic discloses the user of a "Trash Bin" for discarding e-mail whose address would have to be added to the banned list (No Admittance list). It is well known that the GUI interface "Trash Bin" represented by a trash can icon. Clearly, these icon are used in most windowned type operating system. A benefit to this action is that recipient need not perform any special action besides selecting the one button "SPAM" button.

3. Claims 1-20 are pending.

Art Unit: 2664

Claim Rejections - 35 USC § 112

4. Claim 8 “ sending the unsolicited e-mail message to the policy server” is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of “ Here is a zmail ban-spam button” (07 October 1997).

In the claims 1, 13, McCormick et al. discloses a system for policing an unsolicited e-mail (filter junk e-mails)(see figure 3) comprising:

- ◆ a plurality of clients (17, 19), each coupled together using a wide area network (Internet and/or intranet 11) of computer comprising an Internet; a policy server (central e-mail system 21) coupled to each of the plurality of clients (17, 19) through the wide area network (Internet and/or intranet 11) of computers;
- ◆ the policy server being adapted to receive the indication (updated filter addresses) from the client to the policing server (see col.6, lines 33-38, col. 7, lines 45-48).

Art Unit: 2664

McCormick, however, does not disclose an icon on the display, the icon being adapted to send the indication from the client.

“Here is a zmail ban-spam button” (07 October 1997) discloses wherein the e-mail device comprises an SPAM icon (ban-spam button) on the display, the SPAM icon being adapted to send the indication from the client to the policing server (see “Here is a zmail ban-spam button”, to ban repeat spam, you only needs the procmail steps below. The zmail steps simply provide a push-button interface to ban repeat spam).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the McCormick’s system with the teaching of “Here is a zmail ban-spam button” to provide an option icon on the display in order to help the client to speed up removing the Junk mail (SPAM). Therefore, the modified system would have been enable the policy server being adapted updated e-mail filter in response to each client notification.

7. In the claims 2, 14, “ Here is a zmail ban-spam button” discloses the policy server is adapted to report the unauthorized e-mail message (unwanted e-mail message) (see page 2, in fact, if someone does attempt to spam you twice, -- your system now automatically sends tem a system message response of “permission denied”).

8. In the claims 3, 15, McCormick et al. discloses the policy server is adapted to updated a local e-mail filter for the client (25) in response to the unsolicited e-mail (see col. 4, lines 49-56).

9. In the claims 4, 16, McCormick et al. discloses each of clients (17, 19) comprises an updated e-mail filter from the policy server (central location 21) (see figure 3, col.4, lines 48-56).

Art Unit: 2664

10. In the claims 5, 17, McCormick et al. discloses the policy server comprises a log of the unsolicited e-mail (see figure 3, col.4, lines 48-56).

11. In the claim 6, McCormick et al. discloses the unsolicited e-mail message is SPAM (see figure 2, col.4, lines 8-14).

12. In the claims 7, 18, 19, McCormick et al. discloses the display comprises a browser program, the browser program being coupled to the e-mail device (see figure 3, web browser or e-mail access application).

13. In the claim 8, McCormick et al. discloses each of the plurality of clients (17, 19) is for a different user, where each user is capable to sending the unsolicited e-mail message to the policy server (central location 21) (see col. 4, lines 49-56).

14. In the claim 9, McCormick et al. discloses the policy server (centralized server 21) comprises a plurality of SPAM filters (see figure 3, col.4, lines 49-56).

15. In the claim 10, McCormick et al. discloses each of clients (17, 19) is coupled to the wide area network (Internet 11) of computers through an Internet service provider (see figure 3).

16. In the claim 18, McCormick et al. discloses the client comprising an e-mail client program (19, figure 3).

17. In the claim 19, McCormick et al. discloses the client client comprising a browser program (see figure 3).

Art Unit: 2664

18. Claims 11-12, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (McCormick - "Here is a zmail ban-spam button") in view of Courtney Macavinta (Staff Writer, CNET News.com "June 12, 1997").

In the claims 11, 20, the combined system (McCormick - "Here is a zmail ban-spam button") discloses the limitations of claim 1 above.

However, the combined system (McCormick - "Here is a zmail ban-spam button") is silent to disclosing the policing server is provided at a government authority.

Courtney Macavinta (Staff Writer, CNET News.com "June 12, 1997") discloses the FTC (Federal Trade Commission) made is clear that is already has the authority to crack down on junk emailer who engage in unfair or deceptive practice. The agency can obtain orders to shut down fraudulent mass marketing. It can also impose fines of up to \$11,000 of each act of contempt if a company fails to abide by an agreement with the agency to clean up its act (see page 1, lines 5-8); comprising:

- ◆ the policing server is provided at a government authority (see page 1, lines 5-8, the FTC (Federal Trade Commission) made is clear that is already has the authority to crack down on junk emailer who engage in unfair or deceptive practice. The agency can obtain orders to shut down fraudulent mass marketing. It can also impose fines of up to \$11,000 of each act of contempt if a company fails to abide by an agreement with the agency to clean up its act, see page 1, lines 25-26, member of the IMC (internet marketing council) will also have to offer customer to direct opt-out and comply with an ethics code that prohibits.

Art Unit: 2664

sending deceptive messages, see page 1, lines 27-28, it too calls for spammers to offer an opt-out choice. It also has an "email preference" option that allows consumers to remove their names from marketing email list, see page 1, lines 39-40, the bill aims to promote e-commerce by protecting consumer and ISP from bulk unsolicited email, giving the FTC (Federal Trade Commission) more authority to bust spammers who don't give an opt-out preference. It would make false return addresses illegal for commercial emailer, punishable by a fine of up to \$5,000).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (McCormick - "Here is a zmail ban-spam button") with the teaching of to provide the policy server (which is provided at a government authority) in order to stop the junk email senders.

19. In the claim 12, Courtney Macavinta (Staff Writer, CNET News.com "June 12, 1997") discloses the policing server is from an enforcement agency (Federal Trade Commission) (see page 1, lines 25-26, member of the IMC (internet marketing council) will also have to offer customer to direct opt-out and comply with an ethics code that prohibits sending deceptive messages, see page 1, lines 27-28, it too calls for spammers to offer an opt-out choice. It also has an "email preference" option that allows consumers to remove their names from marketing email list, see page 1, lines 39-40, the bill aims to promote e-commerce by protecting consumer and ISP from bulk unsolicited email, giving the FTC (Federal Trade Commission) more authority to

Art Unit: 2664

bust spammers who don't give an opt-out preference. It would make false return addresses illegal for commercial emailer, punishable by a fine of up to \$5,000).

20. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2664

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuong Ho whose telephone number is (571)272-3133. The examiner can normally be reached on Monday-Friday from 9am to 3pm.
22. Any inquiry of a general nature or relating to the status of this application or proceeding should be direct to the group receptionist whose telephone number is (703) 305-3900.

CH

Date 09-08-04

A handwritten signature in black ink, consisting of stylized, overlapping loops and a long horizontal stroke extending to the right.